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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,241	12/17/2001	Philip M. Ginsberg	CF-16	3705
64558	7590	10/15/2007	EXAMINER	
ROPES & GRAY LLP			DASS, HARISH T	
PATENT DOCKETING 39/361			ART UNIT	
1211 AVENUE OF THE AMERICAS			PAPER NUMBER	
NEW YORK, NY 10036-8704			3692	
			MAIL DATE	DELIVERY MODE
			10/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/023,241	Applicant(s) GINSBERG, PHILIP M.	
	Examiner Harish T. Dass	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 23, 25, 27, 32, 33, 37, 43, 50-53 and 55-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 23, 25, 27, 32-33, 37, 43, 50-53, 55-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. *Status of Claims:*

Claims 1-12, 14-22, 24, 26, 28-31, 34-36, 38-42, 44-49, 54 are canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 55-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is a system claim and in line 2 recites "a plurality of communication links ..." it is not clear if these links are hardware links or software links (i.e., they are only declared and provisioned as software module, in software package, to receive/transmit data from/to workstations or hardwired links, e.g., print or scan functions).

Claim 13 line 6 recites "a commission processing module" not clear if it is a hardware module or software module (assume it is a software module). Now the question is whether "workstations" are part of the system or not. If the "workstations" are not part of the claim, then the claim is indefinite and not a system claim. Otherwise, if the "workstations" are part of the claim, then they should be claimed positively, or amend the claim properly to reflect a system claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 23, 25, 32-33, 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gianakouros in view of Hawkins et al. (Hawkins - US 6,029,146).

Re. Claim 13, Gianakouros discloses a plurality of communications links designed to communicate trade information to and from a plurality of workstations, the trade information comprising information describing orders in an electronic market for items offered for sale or bid to buy, at least some of the trade information to be presented to the workstations and a commission processing module designed to receive information relating to execution of trades in the items, and to determine a commission payable by a customer to a trade, or to apply a credit against commission fees to the customer [para 20, 35, 40-49, 57];

Gianakouros does not explicitly disclose commission of a trade based at least in part on one or more characteristics from the group consisting of the time of the trade, day of the trade, location of a trade, and the customer trading location. However, Hawkins discloses this feature [Figure 10 (commission bases) Figure 12 (place of trade and trade date; settlement date) Figure 21 (charges), col. 1 lines 4-43, line 52; col. 8

Art Unit: 3693

lines 13-57; col. 13 lines, 57-63 (commission basis); col. 14 lines 38-48; col. 17 line 39 to col. 18 line 13]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and include commission & fee bases (see above), as discloses by Hawkins, to be paid by the trader as trader and broker have agreed between them to compensate the broker for his/her services.

Re. Claims 23 and claim 25 are rejected with same rational as claim 13.

Re. Claims 32-33, Gianakouros wherein the commission is further based on whether at least one of said two customers was active or passive during said trade [see at least claim 21], and wherein the commission is further based on a class which includes said item [para 23-33 and commission, equity, stocks].

Re. Claims 55-69, Gianakouros discloses sell and buy side of a security (items similar to said item being traded by said customer were traded by other customers at the time, day, or location said item was traded by said customer) and customer for participating in at least part of said trade [abstract; para. 33; 40]. Hawkins discloses trading charges based in part on time, location, level of liquidity, etc as disclosed above. Spread are known, the more the spread more is the commission. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and include commission & fee bases (see above), as

Art Unit: 3693

discloses by Hawkins, to be paid by the trader as trader and broker have agreed between them to compensate the broker for his/her services.

- 5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gianakouros and Hawkins, as applied to claim 25 above and further in view Koppelman et al. (hereinafter Koppelman – US 6,662,164).**

Re. Claim 27, Koppelman discloses assigning ***at least one*** of said two customers (***buyer/seller***) said commission based on the ***one or more*** attributes of the trade; and presenting said commission to said ***at least one*** of said two customers. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and Hawkins and include the distribution commission (display commission) as disclosed by Koppelman to inform the client what he is paying for trading and allow him/her to choose to execute a trade or not.

- 6. Claims 37, 43, 50-53, and 70-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gianakouros, Hawkins and Koppelman.**

Re. Claim 37, Gianakouros discloses providing control logic designed to determine a commission payable by a customer to a trade, **or** to apply a credit against commission

Art Unit: 3693

fees to the customer, based at least in part on one or more attributes of a trade of an item arranged by a computer system between at least two customers.

Hawkins disclose one or more attributes being drawn from the group consisting of the time of the trade, day of the trade, location of the trade, and customer trading location [Figure 10 (commission bases) figure 12 (place of trade and trade date; settlement date) Figure 21 (charges), col. 1 lines 4-43, line 52; col. 8 lines 13-57; col. 13 lines, 57-63 (commission basis); col. 14 lines 38-48; col. 17 line 39 to col. 18 line 13]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and include commission & fee bases (see above), as discloses by Hawkins, to be paid by the trader as trader and broker have agreed between them to compensate the broker for his/her services. Koppelman discloses storing in the memory_ of the computer system for offset against future commissions an amount of a reward based at least in part on the characterized attribute of the trade. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and Hawkins and include the above features disclosed by Koppelman to evaluate desired level of performance earn by the recipients and provide credit incentive toward future trading in form of reward.

Re. Claim 43, Gianakouros discloses wherein the commission is further based on whether said customer was active or passive during said trade.

Art Unit: 3693

Re. Claims 50-53 and 70-77, Gianakouros discloses sell and buy side of a security (items similar to said item being traded by said customer were traded by other customers at the time, day, or location said item was traded by said customer) and customer for participating in at least part of said trade [abstract; para. 33; 40]. Hawkins discloses trading charges based in part on time, location, level of liquidity, etc as disclosed above. Spread are known, the more the spread more is the commission. Gianakouros or Hawkins does not explicitly disclose determining said reward, reward comprises determining whether said customer is a new customer, rewarding said customer for participating in at least part of said trade, and determining a rebate, a credit, or both assigned to said customer. However, assign new customer for rebates and credit (determining whether said customer is a new customer, rewarding said customer for participating in at least part of said trade, and determining a rebate, a credit, or both assigned to said customer) are known. For example, most of store provide incentive to new customer to apply for store credit card and they will receive 10% credit and rebates for using their cards. It is obvious that to attract new customer and compete with others, store provide these incentives. Koppelman discloses determining said reward, reward [see supra]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Gianakouros and Hawkins and include the above feature disclosed by Koppelman in order to calculate the rewards and bonus for eligible clients based on clients activity.

Response to Arguments

7. Applicant's arguments (9/4/07) with respect to rejections of claims under 35 USC 101 and 35 USC 112 of previous office action (paper number 20070529) have been considered and appropriate corrections are made.

Conclusion

8. Claims 13, 23, 25, 27, 32-33, 37, 43, 50-53, 55-77 remain rejected under 35 USC 103(a), and

Claims 13, 55-63 are rejected under 35 USC 112 2nd paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Primary Examiner
Art Unit 3693

Harish T Dass

10/02/07